

DETAILED ACTION

1. Claims 6, 9, 19-23 and 32-37 have been examined.
2. Claims 3 and 5 are canceled.

Election/Restrictions

3. Applicant's election of Species II (Claims 6, 9, 19-23 and 32-37), in the reply filed on 16 June, 2008 is acknowledged. However, because the Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P 818.03(a)).

Please note the Applicant incorrectly states "...Species 2: claims 6, 9, **18**-23 and 32-37 are elected" rather than "...claims 6, 9, **19**-23 and 32-37". The examiner believes it is an unintentional typo error.

Therefore, Claims 1-2, 4, 7-8, 10-18, 24-31 and 38-57 are hereby withdrawn from consideration.

Response to Amendment

4. The Applicant's amendment, filed 6 February 2008, has been received, entered into the record, and respectfully and carefully considered.
5. As a result of the amendment, claims 1-2, 4, 6-10 and 15-16 have been amended. Claims 3 and 5 are canceled. Claims 17-57 are newly added claims. Claims 1-2, 4 and 6-57 are pending. Claims 1-2, 4, 7-8, 10-18, 24-31 and 38-57 are withdrawn from consideration due to restriction requirement. Claims 6, 9, 19-23 and 32-37 have been examined.
6. Any previous claim objection/rejection not repeated below since they are directed to non-elected claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 20 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 20 and 34, they recite “(i) receive a third user input to establish a communication link, and (ii) activate the processor to provide output data to establish the communication link, wherein the output data comprises link information included in the extracted information represented by the hidden data”. It appears to the examiner there are **three different** user inputs being recited in the claims. The examiner carefully and respectfully reviewed the original disclosure, for example, in par. [0105], lines 24-26, the Applicant discloses “receive a first input from the user...in accordance with the first user input”. Where is the second user input in the original disclosure at the time of the filing? Additionally, in par. [0103], lines 29-30, the Applicant discloses “purchase an advertised product **or** may desire more information about the song...”. Par. [1036] again discloses “...a user interface 42 for permitting a user to either activate an information mode **or** enter choices regarding displayed information...”. Though “additional information” is in the par. [1036], it does not disclose requesting “additional information” as a second user input and receive a third user [input] to establish a communication link. Instead, there is one user input discloses in the original disclosure.

“[T]he test for sufficiency of support...is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at the time of the later claimed

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subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

“Application sufficiency under § 112, first paragraph, must be judged **as of the filing date [of the application]**.” *Vas-Cath*, 935 F.2d at 1566, 19 USPQ2d at 1119 (citing *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989)).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 6, 9, 19-22 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over August (U.S. Patent No. 6,125,172) in view of Henderson (U.S. Patent No. 6,427,064) and further in view of Haverty (U.S. Patent No. 6,088,586).

As per **claims 6 and 9**, August discloses a portable communication device comprising:

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a receiver (“an acoustic data receiver has microphone for receiving an audio signal...” – e.g. col. 2, lines 53-57) structured for receiving sound waves (“...and microphone for receiving an audio signal having encoded data that is non-discernable by a listener...” – e.g. abstract), the sound waves being representative of (i) an audio signal (“..continuously receives the audio signal, for instance using microphone 14...” – e.g. col. 3, ll. 17-18) and (ii) hidden data embedded in the audio signal (“...The data may include information for initiating a transaction or originating a telephone call, as well as additional information (e.g. price and ordering information)...” – e.g. col. 6, lines 54-67), the microphone converting the received sound waves into an electrical output signal (“The microphone converts the sound waves into an electrical signal” – e.g. abstract and col. 4, lines 11-16);

a processor (“microprocessor 220” in fig. 6) electrically coupled to the microphone and configured to receive the electrical output signal in order to extract the hidden data and provide information represented by the hidden data (“A processor receives the electrical signal and retrieves transaction data that is part of the encoded data...Once the transaction data is retrieved, a telephone call can be originated and at least a portion of the transaction data can be transferred to a desired destination for initiating a transaction” – e.g. abstract. Please note transaction data corresponds Applicant’s extract the hidden data);

a user interface (“button interface 240” in fig. 6) electrically coupled to the processor and configured to (i) receive a first input from the user and (ii) activate the processor to selectively initiate extraction of the hidden data in accordance with the first user input to provide extracted information represented by the hidden information (e.g. “...an apparatus initiates a transaction...and microphone for receiving an audio signal...The microphone converts the sound waves into an electrical signal...Once the **transaction data** is retrieved...for initiating a transaction” – e.g. abstract) (iii)

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receive a second user input indicative of user preferred portions of additional information related to the extracted information represented by the hidden data, and (iv) activate the processor to provide the user preferred portions of the additional information in response to the second user input (“The data may include information for initiating a **transaction**...as well as **addition information** (e.g., price and ordering information associated with the television program...” – e.g. col. 6, lines 54-58, “...using the DIAL function. This function is initiated by activation of button 242. With this function, dialing information, which is part of the data captured by capture device 110 and now stored in memory, is retrieved..’ – e.g. col. 10, II. 30-35 and “When a user of capture device 110 desires to use any of the data stored in memory 221,...by initiating the RECALL function upon activating button 226...Through this function, the user will be able to selectively peruse or scroll through the stored data, so as to retain or use selected portions thereof” – e.g. col. 9, lines 43-59. Please note transaction data and additional information are distinguished from each other) , wherein the processor provides the extracted information represented by the hidden data in response to the first user input (e.g. “...an apparatus initiates a transaction...and microphone for receiving an audio signal...The microphone converts the sound waves into an electrical signal...Once the transaction data is retrieved...for initiating a transaction” – e.g. abstract), and provides the user preferred portions of the additional information in response to the second user input (e.g. col. 6, lines 54-58, col. 9, lines 43-59 and col. 10, II. 30-35); and

a user presentation mechanism (“Display 225” in fig. 6) configured to present the 3extracted information represented by the hidden data (“..while a display, such as an LCD screen, can display at

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least a portion of the transaction data to a user. The transaction data can include dialing information...can also include descriptive information..." – e.g. col. 3, lines 20-32).

An output mechanism electronically coupled to the processor (Display 225 in fig. 6 electronically connected to Microprocessor 220 in fig. 6) and configured to receive the output from the processor ("the microprocessor 220 may control display 225 to indicate the current status...When the data has been captured, the microprocessor 220 may control the display 225 to actually display some or all of the data..." – e.g. col. 8, lines 57-61);

August discloses in col. 4, lines 4-5, "a source of an audio signal, indicated generally at 10a" and in col. 4, lines 6-11, August discloses, "...It can be a radio 11 or the audio channel of a television...". It is common knowledge in the art at the time of the invention that a radio frequency signal is similar to those used by television and FM radio stations.

August does not expressly disclose a broadcast signal is a radio frequency signal.

Henderson discloses in col. 11, lines 1-22, a broadcast signal is a radio frequency signal.

At the time of the invention it would have been obvious to a person with ordinary skill in the art to incorporate Henderson's a broadcast radio frequency signal into August's system since it is common knowledge in the art at the time of the invention that a radio frequency signal is similar to those used by television and FM radio stations and radio frequency communication is conventional.

August – Henderson does not expressly disclose an embedding unit for embedding the output with identification information associated with the portable communication device.

However, Haverty discloses "Information embedded in the current RCC signal transmissions....includes...: the Mobile ID (MID)...the Electronic Serial Number (ESN) that identifies the specific handset..." – e.g. col. 1, line 66- col. 2, line 9, which met the claimed limitation of an

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embedding unit for embedding the output with identification information associated with the portable communication device.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Haverty's an embedding unit for embedding the output with identification information associated with the portable communication device into August – Henderson in order to track subscriber's information.

As per **claims 19 and 32**, August further discloses a transmitter to transmit a signal corresponding to the embedded output (e.g. col. 1, line 57 – col. 2, line 1, col. 10, lines 31-43, col. 10, line 65- col. 8, line 22 and "an acoustic transmitter can be a separate device for transmitting an encoded information signal such as a sound wave..." - e.g. col. 4, lines 6-8).

As per **claims 33**, August further discloses wherein the transmitted signal activates computer network function (e.g. col. 6, line 63- col. 7, line 25 and col. 12, lines 34-50).

As per **claims 20 and 34**, August further discloses wherein the user interface is further configured to (i) receive a third user input to establish a communication link, and (ii) activate the processor to provide output data to establish the communication link, wherein the output data comprises link information included in the extracted information represented by the hidden data (e.g. col. 6, line 63 – col. 7, line 25).

As per **claims 21 and 35**, August further discloses wherein the embedded output is for an entity rendering a service to provide the hidden data (e.g. col. 4, lines 16-25 and col. 6, lines 49 – col. 8, line 10).

As per **claims 22 and 36**, Haverty further discloses wherein the identification information for the portable communication device is a serial number of the portable communication device (e.g. col. 1, line 66- col. 2, line 9).

12. Claims 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over August (U.S. Patent No. 6,125,172) in view of Henderson (U.S. Patent No. 6,427,064) - Haverty (U.S. Patent No. 6,088,586) and further in view of Linehan (U.S. Patent No. 6,983,255).

As per **claims 23 and 37**, August further discloses wherein the output further comprises a user's purchasing selection related to the extracted information (col. 4, lines 16-25 and col. 6, lines 49 – col. 8, line 10).

August – Henderson – Haverty does not explicitly disclose wherein the identification information facilitates allocation of revenue generated from the user's purchasing selection.

However, Linehan discloses a technique for extending payment protocols to include identification of the provider when a purchase is initiated. The provider's identification is used, to enable TV originators to share in the profits (e.g. as a percentage of the sales totals) associated with viewer purchase (e.g. col. 2, lines 40-53), which met the claimed limitation of wherein the identification information facilitates allocation of revenue generated from the user's purchasing selection.

It would have been obvious to a person with ordinary skill in the art at the time of invention to incorporate Linehan's wherein the identification information facilitates allocation of revenue generated from the user's purchasing selection into August – Henderson – Haverty motivated by "It would be advantageous if various organizations responsible for delivering television programs were able to

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automatically share in the profits generated by this shopping paradigm" (e.g. 2, lines 25-28 of Linehan).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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